

THIS OPINION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

lms

Mailed: February 14, 2005

Opposition No. **91157069**

K.P. Sports, Inc.

v.

Armor Gear LLC

Before Hohein, Holtzman and Rogers,
Administrative Trademark Judges

By the Board:

Two applications have been filed by Armor Gear, LLC for the marks ARMOR GEAR¹ and ARMOR GEAR and design,² as shown below,



for "luggage, namely, trunks, travel bags, carry on bags, duffel bags, backpacks, fanny packs, shoe bags for travel,

¹ Ser. No. 78139227 was filed on June 26, 2002, claiming a date of first use of March 15, 2002 and first use in commerce of May 16, 2002; "gear" is disclaimed. The application was inadvertently issued as Reg. No. 2827692 on March 30, 2004 after this proceeding had been instituted. Accordingly, such registration will be forwarded to the Office of the Commissioner for Trademarks for appropriate action.

² Ser. No. 78139230 was filed on June 26, 2002, claiming a date of first use of March 15, 2002 and first use in commerce of May 16, 2002; "gear" is disclaimed.

travel bags for golf clubs, shoulder bags, gym bags, athletic bags, all-purpose sports bags, brief bags, travel bags for laptop computers, travel bags for laptop accessories and discs, garment bags for travel, toiletry cases sold empty" in International Class 18.

The applications have been opposed by K.P. Sports, Inc., claiming ownership of two registrations for the mark UNDER ARMOUR³ as well as two registrations⁴ and three pending applications for marks containing the word GEAR (hereinafter "GEAR marks") for "a wide variety of apparel".⁵

³ Reg. No. 2279668, issued September 21, 1999, is for the mark UNDER ARMOUR for "clothing, namely, T-shirts, long sleeve shirts, turtle necks, mock turtle necks, hats, shorts, shirts, leggings, jerseys, pants, headwear for winter and summer, under wear, tank tops (male and female), winter caps, sweat shirts/pull overs, womens bra" in International Class 25.

Reg. No. 2509632, issued November 20, 2001, is for the mark UNDER ARMOUR and design, as shown below,



UNDER ARMOUR

for "clothing namely, shirts, hats, pants, T-shirts, underwear, brassiere and shorts" in International Class 25.

⁴ Reg. No. 2692752, issued March 4, 2003, is for the mark HEATGEAR, for "clothing, namely, T-shirts, shorts, shirts, leggings, underwear, tank tops and women's bras" in International Class 25.

Reg. No. 2663055, issued December 17, 2002, is for the mark TURFGEAR, for "clothing, namely, long sleeve shirts, turtle necks, mock turtle necks, shorts, shirts, leggings, underwear, shorts" in International Class 25.

⁵ The applications identified as pending in the notice of opposition have since registered. They are: Reg. No. 2774679, issued October 21, 2003, for the mark LOOSEGEAR, for "clothing,

Opposer alleges that applicant's marks, when used on or in connection with applicant's goods, are likely "to cause confusion, to cause mistake, or to deceive"; and that opposer's UNDER ARMOUR marks are famous and will be diluted by registration of applicant's ARMOR GEAR marks.

In its answer, applicant denied all the salient allegations of the notice of opposition.

This case now comes up on applicant's motion for summary judgment on likelihood of confusion and dilution, filed June 4, 2004.⁶ As grounds for its motion, applicant contends that the marks are different; that the parties' goods are unrelated; that the word "armor" is weak and the word "gear" is descriptive; and that dilution cannot be proven given the numerous third-party uses of "armor" and the dissimilarity of the marks at issue.

namely, T-shirts, long sleeve shirts, tank tops, shorts and shirts" in International Class 25;

Reg. No. 2842211, issued May 18, 2004 under § 2(f), for the mark COLDGEAR, for "clothing, namely, shirts" in International Class 25; and

Reg. No. 2844252, issued May 25, 2004 under § 2(f), for the mark ALLSEASONGEAR, for "clothing, namely shirts" in International Class 25.

⁶ The delay in deciding this motion was occasioned when opposer filed a motion to compel virtually simultaneously with the time applicant filed the motion for summary judgment. The Board suspended proceedings based on the motion to compel and opposer argued that it need not respond to the motion for summary judgment based on the suspension order. The motion to compel was denied on August 30, 2004 and opposer was allowed time to respond to the motion for summary judgment.

Opposer has responded and contends that the marks are similar; that the goods are similar; that it manufactures and sells clothing items and accessory items used by athletes and the general public that include duffel bags and equipment bags; that it does so under its UNDER ARMOUR and various "GEAR" marks; that such use pre-dates applicant's use of its marks; that opposer's goods are extensively marketed throughout the United States in all channels of trade; that applicant's channels of trade and advertising are not limited and, in fact, include the same avenues of commerce as opposer uses; that both parties' goods are presumably sold to the same class of purchasers; and that opposer's marks are well-known and famous.

The burden is on the party moving for summary judgment to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). *See also, Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The evidence of record and any inferences, which may be drawn from the underlying undisputed facts, must be viewed in the light most favorable to the non-moving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In considering the propriety of summary judgment, the Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether

such issues are present. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); and *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

In support of its motion, applicant submitted the declaration of Sharon R. Smith, applicant's attorney, with copies of printouts from the USPTO database of third-party registrations containing the terms "gear" and "armor" or "armour"; and the declaration of Tim Harrington, CEO for applicant, attesting to applicant's dates of use; and the extent of use of its two involved ARMOR GEAR marks; and offering evidence found on the Internet of third-party uses of the terms "gear", "armour" and "armor" for the same or similar goods as those involved herein.

In support of its opposition to the motion, opposer submitted⁷ the declaration of Scott Plank, Chief

⁷ It is noted that opposer's entire submission was filed as a confidential document and under seal. Trademark Rule 2.127(d) provides that if a party submits a motion containing confidential information under seal, the party must also submit for the public record a redacted version of the motion. In that the motion itself contained no identifiable confidential information, it has been entered into the public record. The exhibits to the submission remain under seal. See also Trademark Rule 2.27(e).

Moreover, it is not clear why the entirety of opposer's declarations and the supporting exhibits were submitted under seal in that the only items that appear to be proprietary are opposer's sales figures (¶ 12 of the Plank declaration) and applicant's response to interrogatory No. 6 (an exhibit to the Girgenti declaration). The other items appear to be publicly available. Accordingly, opposer is allowed until 20 days from the date of mailing of this order to submit a copy of the declarations and exhibits for the public record with any confidential material redacted. If no response to this order is

Administrative Officer of opposer, attesting to opposer's use of its marks and referencing attached photocopies of status and title copies of the registrations claimed by opposer; and the declaration of John Girgenti, a paralegal from opposer's counsel's law firm, introducing some of applicant's discovery responses, and supporting photocopies of printouts from the LEXIS news database; printouts from the USPTO database of applicant's subject applications; and printouts of various third-party web pages.

Having carefully considered the materials and arguments submitted by the parties in connection with their motions, we reach the following conclusions:

Dilution

In support of the motion for summary judgment on this issue, applicant points to third-party use of the terms "armor" and "gear" and contends that dilution cannot be established because opposer's marks are not so distinctive that the public immediately associates the UNDER ARMOUR mark with opposer, and, primarily, that the marks at issue are not essentially the same for purposes of the dilution claim.

For the Board to find that dilution has occurred, or is likely to occur, we must find that the involved marks are more than merely similar; a party must show that the marks are identical or "very or substantially similar." See *Toro*

received, all of the material will be made part of the public

Co. v. ToroHead Inc., 61 USPQ2d 1164, 1183 (TTAB 2001).

While the marks ARMOR GEAR and UNDER ARMOUR share the phonetically identical term "armor", we find that there is no genuine issue that the marks in their entireties are not substantially similar for dilution purposes. This is true for the parties' typed marks, and especially true for the parties' composite word and design marks. Trial of the dilution claim and receipt of evidence on the degree of fame of opposer's marks, and when the marks became famous, would have no bearing on the factual issue regarding the dissimilarity of the marks.

Accordingly, applicant's motion for summary judgment on dilution is granted, and opposer's claim of dilution is dismissed.

Likelihood of Confusion

As to the GEAR Marks

As one of the grounds for its likelihood of confusion claim, opposer compares applicant's ARMOR GEAR and ARMOR GEAR and Design marks to its various GEAR marks used in its apparel line. Opposer explains that in opposer's advertising, its "Gear Marks display the UNDER ARMOUR trademark in close proximity to the GEAR brand being advertised." (Brief in opposition, p. 8) and characterizes its "gear marks" as secondary trademarks (Brief, p. 2).

file.

Further, applicant has established through evidence of third-party use that there is no genuine issue of material fact that the term "gear" is a highly descriptive, if not generic, term for clothing or for equipment that is specially suited for a particular task. Thus, in comparing applicant's marks with each of opposer's "GEAR" marks, the dominant elements of these marks are those portions other than the term "GEAR". The dominant portions of applicant's marks (the word "ARMOR" in both of its marks and the armadillo design in the ARMOR GEAR and Design mark) are not at all similar to the dominant portions of opposer's marks ("HEAT", "TURF", "LOOSE", "COLD", and "ALLSEASON"), in terms of sight, sound, meaning or overall commercial impression. Accordingly, as a matter of law, we hold there is no likelihood of confusion between any one of opposer's "GEAR" marks and either of applicant's ARMOR GEAR marks.

Applicant's motion for summary judgment is granted as to opposer's various "GEAR" marks, and the claim under Section 2(d) based on such marks is dismissed.

As to the UNDER ARMOUR Marks

A determination of whether there is a likelihood of confusion between opposer's UNDER ARMOUR marks and applicant's ARMOR GEAR marks presents a different situation on summary judgment. After a review of the evidence, we find that opposer has raised genuine issues of material fact

as to the strength of its UNDER ARMOUR marks, their distinctiveness and whether they are so strong and distinctive as to be considered famous marks. Put another way, as the moving party, applicant has not shown an absence of a genuine issue that opposer's UNDER ARMOUR marks are, as applicant contends, weak. While applicant has provided several instances of third-party use (e.g., through the Internet) of "armor" or "armour" marks, the evidence is limited and there is no evidence as to how extensive the uses are and whether they are active and continuing at this time. Additionally, there is a genuine issue as to the relatedness of the parties' respective goods and, in particular, the complementary nature of the goods. The issue of likelihood of confusion between applicant's ARMOR GEAR marks and opposer's UNDER ARMOUR marks cannot be resolved by summary judgment.

Applicant's motion for summary judgment is denied as to opposer's section 2(d) claim based on its UNDER ARMOUR marks.

Proceedings are resumed and trial dates are reset as provided below:

Discovery period to close:	CLOSED
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30-day testimony period for party in position of plaintiff to close:	5/15/2005
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30-day testimony period for party in position of	7/14/2005
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defendant to close:

15-day rebuttal testimony period to close:

8/28/2005

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

In sum, applicant's motion for summary judgment is hereby granted as to opposer's claim of dilution and with respect to opposer's claim of a likelihood of confusion based on opposer's "GEAR" marks.⁸ However, summary judgment is denied as to opposer's claim of likelihood of confusion based on opposer's UNDER ARMOUR marks.⁹

⁸ The parties are reminded that our decision granting partial summary judgment is interlocutory in nature and may not be appealed until a final decision is rendered in the proceeding. *Copeland's Enterprises Inc. V. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1565 (Fed. Cir. 1989).

⁹ The parties are reminded that evidence submitted in connection with a motion for summary judgment is of record only for purposes of that motion. If the case goes to trial, the summary judgment evidence does not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate testimony period. See TBMP § 528.05(a) (2d ed. rev. 2004). Further, merely because the Board has identified certain issues as in dispute and concluded that one of opposer's 2(d) claims is not suitable for resolution by

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summary judgment, does not mean that opposer need only offer proof on those issues at trial. In trying the remaining 2(d) claim, the parties are responsible for trying it in full.